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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,139	03/06/2002	William D. Tandy	4333.1US (99-0257.1)	9714

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EXAMINER
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CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 10/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/092,139

Applicant(s)

TANDY ET AL.

Examiner

Victor S Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. New corrected drawings are required in this application because in Fig. 4A there is an apparent error of having two elements 4 pointing to different parts of the drawing. Also, in Fig. 5, the element 1A does not seem to have corresponding element in the Specification. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### ***Specification***

2. The disclosure is objected to because of the following informalities:  
In the Specification, paragraph [0037], please correct "PFTE" to --PTFE--.  
Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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4. Claims 5, 13 and 21 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility.

More particularly, Applicants have not asserted any specific and substantial utility for the claimed invention of "curing said first outermost adhesive layer results in a loss of adhesion between said first outermost adhesive layer and said second adhesive layer" and it does not have a readily apparent well-established utility.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 5, 13 and 21 are also rejected under 35 U.S.C. 112, first paragraph.

Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

7. Claims 5, 13 and 21 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for "curing of said first outermost adhesive layer", does not reasonably provide enablement for "loss of adhesion between said first outermost adhesive layer and said second adhesive layer". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

For claims 5, 13 and 21, the Specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. More particularly, these claims merely set forth physical characteristics desired in a generic first outermost adhesive layer, the lack of any suitable composition which would meet these physical characteristics renders claims 5, 13 and 21 unduly broad and in excess of its provided enablement.

**8.** The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**9.** Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, claims 5, 13 and 21 are also rejected under 35 U.S.C. 112, second paragraph. It should be noted that these claims merely setting forth physical characteristics desired in article, and not setting forth suitable composition which would meet such characteristics are invalid as vague, indefinite, and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in future and which would impart desired characteristics. *Ex parte Slob* (PO BdApp) 157 USPQ 172.

Additionally, it appears that Applicants have made an apparently simple structure unduly confusing by making many similar or redundant claims. For example, independent claims 1, 9 and 17 are de facto duplicates with minor variations in the

preamble stating the use of the tape, and these preambles have not been given patentable weight, because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951). As such, the Examiner strongly suggests that the number of independent and corresponding dependent claims be significantly reduced.

Finally, for article claims 2-4, 6, 10-12, 14, 18-20 and 22, it appears these claims are directed to the steps of use, and lack any additional structural element. As such they are clearly improper and informal. The Examiner suggests that these claims should be re-written as process of use.

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1, 7-9, 15-17 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weng et al. (US 5972234).

Weng's invention is directed to a laser mark tape for marking an electronic substrate, and creating a mark through the tape by a high-intensity energy beam. In one embodiment, Weng teaches marking the tape with an identification mark by a high-

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intensity energy beam (column 2, lines 20-21). Weng also teaches that when an adhesive-backed polymeric tape is used, an extra release layer, such as polypropylene or PET film, may be provided to cover the adhesive layer for protection during the laser marking process (column 4, line 64 to column 5, line 2).

For claims 1, 9 and 17, Weng's laser mark tape reads on the laser-markable outermost adhesive layer of the instantly claimed invention. Although Weng lacks an express teaching the laser mark tape is formed from an adhesive comprising radiation-curable components, it is noted that Weng does expressly teach that any suitable tape of polymeric based material, which can be easily patterned by high-intensity energy beams such as ultraviolet light or laser, can be used (column 4, lines 27-33). As such, it is believed that the use of a polymeric tape with laser-markable radiation curable components in the adhesive layer is either inherently disclosed, or an obvious optimization to one skilled in the art of radiation curable polymers, motivated by the desire to obtain a suitable marking and improved adhesion.

For claims 7, 15 and 23, although Weng is silent about the use of a radiation curable adhesive for the adhesive layer to adhere the laser mark tape to the semiconductor die, it is noted that Weng's invention is essentially the same as the instantly claimed invention, as such it is believed that a radiation curable adhesive is either inherently disclosed or an obvious optimization to one skilled in the art of adhesion, motivated by the desire to obtain a strong bonding of the laser mark tape to the die surface.

For claims 8, 16 and 24, the Examiner notes that Weng's polypropylene release layer is inherently translucent.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

VSC

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1800-  
1700

*Daniel Zinker*